REMARKS

Claims 13 and 20 were pending at the time of the Office action.

Claim Rejections – 35 USC §102

Examiner's Rejection

The Examiner has previously rejected claims 13 and 20 under 35 USC §102(e) as being anticipated by Kenyon (U.S. Patent Application Publication 2002/0023020 A1).

The Examiner has now rejected the Applicant's declaration under 37 C.F.R. §1.131 made to swear behind and overcome the rejection. The Examiner states that the evidence in support of the declaration that was attached to the declaration as Exhibit A (first page of a patent search request) and Exhibit B (first two pages of a patentability opinion) must disclose actual dates. The Examiner also states that the declaration does not state where the invention was conceived.

The dates of Exhibit A and B are now provided in the 37 C.F.R. §1.131 declaration. In addition, a statement that conception was made in Poland a WTO country has been added to the declaration. A declaration has also been made by the practitioner that reasonable diligence was taken in constructive reduction to practice of the invention from a date prior to September 21, 1999 to filing of the provisional application on October 7, 1999.

Accordingly, the Applicant respectfully requests that the rejection is removed and that, in view of the arguments set forth above, prompt reconsideration and allowance of the claims is earnestly requested.

Respectfully submitted,

HAHN LOESER & PARKS, LLP

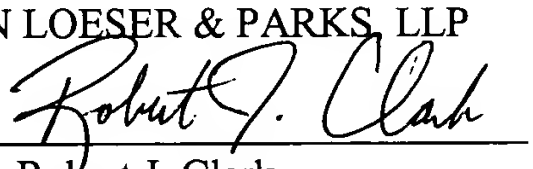
By 

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EXHIBIT A

OLDHAM & OLDHAM CO., L.P.A.
INTELLECTUAL PROPERTY LAW
AND LITIGATION MATTERS

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ALBERT H. OLDHAM (1908-1974)
VERN L. OLDHAM (1912-1988)

OF COUNSEL
BRUCE H. WILSON
LOUIS F. KREEK, JR.

1947 50 years 1997

April 27, 1999

Sidney Kearns
P.O. Box 1720
Bowie, MD 20717

RE: One Patentability Search and One State-of-the Art Search

Dear Sidney:

Please accept this letter as authorization to conduct the following searches.

Music Identification System (File No. 5713). Generally, this concept is a quick method for identifying a song or artist from a short sound clip or sound byte. The inventor's idea is that a user who hears a piece of music on the radio or at any venue, could tape a short segment of the music and have it identified through a database. More specifically, the contemplated invention is for a user to have a recording device for recording short sound clips or sound bytes of an audio (or perhaps the audio portion of a video). The recorder, similar or identical to technology memo recorders (tape or digital) might be of the size which could be attached to a key chain. The user would then record a short segment of the song or audio onto the recorder. The user would then play the sound byte from the recorder into a database (contemplated as either a free-standing kiosk or over the Internet). The database would identify the entire song, based on the sound byte it received and would immediately provide the use with information such as the title, artist, album or cd. The database could further provide information on where the item could be purchased or could provide a mechanism for ordering the music selection online.

[redacted]

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EXHIBIT B

OLDHAM & OLDHAM CO., L.P.A.
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May 20, 1999

Mr. Remi Swierczek
REMEX 2
43-150 Bierun
Torowa 27
Poland

CONFIDENTIAL LEGAL OPINION

Re: Patentability / Search Report for Music Identification System
Our File No. 5713-SCH

Dear Remi:

With respect to your concept, and as you may know from prior patent searches, patentability has three requirements: **novelty**, **usefulness** and **non-obviousness**. The **novelty** requirement, under patent law, requires that the invention is new and has not been previously disclosed in a single-printed reference (whether in a patent or other printed publication) and that it has not been known to the public for more than one (1) year. The **usefulness** requirement is satisfied upon minimal proof that the invention is operable and can function as a benefit to humanity. The **non-obviousness** requirement means that the invention, as a whole, must not be disclosed when viewed in light of one or more referenced publications known prior to the invention. In other words, a patent will not be granted if it would be logical to combine the teachings of two (2) or more references to arrive at the submitted invention.

[redacted]

As I understand your invention, it is a music identification system wherein a user may record a short segment of music and identify it through an automated database. The user who hears a piece of music on the radio or at any music venue could tape a short segment of the music and have it identified through the database. The user would operate a recording device for recording short sound clips or sound bytes of an audio, or perhaps the audio portion of a video. The recorder, similar or identical to technology memo recorders (tape or digital) might be of a size

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which could be attached to a key chain. After recording a short segment of a song the user would play the sound byte from the recorder into the automated database. The automated database could be configured as either a free-standing kiosk or over the Internet. The database would identify the entire song, based on the sound byte it received and then immediately provide the user with information such as the title, artist, album or CD. The database could further provide information on where the item could be purchased or could provide a mechanism for ordering the music selection.

[redacted]

[redacted]

[redacted]

[redacted]

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